REMARKS

Claims 1-4, 8-13, 17-22, 26, and 27 are pending in the present application. Claims 1-4, 8-11, 13, 17-20, 22, 26, and 27 have been amended and claims 5-7, 14-16, and 23-25 are canceled. Claims 1-4, 8-12, 17-21, 26, and 27 have been amended to correct minor informalities. Claims 1, 10, and 19 were further amended to incorporate the subject matter of canceled dependent claims 5-7, 14-16, and 23-24, thus, no new subject matter has been added. Reconsideration of the claims in view of the above amendments and the following remarks is respectfully requested.

I. 35 U.S.C. § 112, Second Paragraph

The examiner has rejected claims 1-27 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, which applicant regards as the invention. This rejection is respectfully traversed.

Claims 1, 2, 4, 8-11, 13, 17-20, 22, 26, and 27 are amended for clarity by providing proper antecedent basis for the identified elements. Therefore, applicant requests withdrawal of the rejection of claims 1, 2, 4, 8-11, 13, 17-20, 22, 26, and 27 under 35 U.S.C. § 112, second paragraph. Since claims 3, 12, and 21 depend from claims 1, 10, and 19, applicant requests withdrawal of the rejection of claims 3, 12, and 21 under 35 U.S.C. § 112, second paragraph.

II. 35 U.S.C. § 101

The examiner has rejected claims 1-9 under 35 U.S.C. § 101 as being directed towards non-statutory subject matter. This rejection is respectfully traversed.

Claims 1-4, 8, and 9 have been amended to recite a **computer implemented** method for customizing direct marketing materials. The examiner alleges that claims 1-8 set forth non-functional descriptive material but fail to set forth physical structure of material of hardware or a combination of hardware and software within the technological arts (i.e., a computer) to produce a "useful, concrete, and tangible" result. Applicant

respectfully submits that the steps of developing, scoring, determining, and using are functional steps that are performed in a computer. The present amendments stating a **computer implemented** method in claim 1 indicates that the developing, scoring, determining and using steps are performed by a computer. The claimed invention presents tangible results in that a reformatted page is presented.

Therefore, independent claim 1 in its amended form is statutory. Since claims 2-4, 8, and 9 depend from claim 1, these are statutory as well. Thus, the rejection of claims 1-4, 8, and 9 under 35 U.S.C. § 101 has been overcome.

III. 35 U.S.C. § 102, Alleged Anticipation, Claims 1, 9, 10, 18, 19, and 27

The examiner has rejected claims 1, 9, 10, 18, 19, and 27 under 35 U.S.C. § 102(b) as being anticipated by Roberts et al. (EP 0 952 539 A2) (hereinafter "*Roberts*"). This rejection is respectfully traversed.

Claim 1, which is representative of the other rejected independent claims 10 and 19 with regard to similarly recited subject matter, has been amended to incorporate the subject matter of claims 5-7. Since the present rejection under Roberts does not reject the subject matter of claims 5-7 under *Roberts*, *Roberts* does not teach every element of the claimed invention arranged as they are in amended claim 1. Specifically, *Roberts* does not teach an optimization model used to customize the layout areas that is at least one of a transportation model, a network model, or a generalized network model. Similar amendments have been made to claims 10 and 19.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983).

Thus, *Roberts* does not teach each and every feature of independent claims 1, 10, and 19 as is required under 35 U.S.C. § 102. At least by virtue of their dependency on independent claims 1, 10, and 19, the specific features of dependent claims 9, 18, and 27 are not taught by *Roberts*. Accordingly, applicant respectfully requests withdrawal of the rejection of claims 1, 9, 10, 18, 19, and 27 under 35 U.S.C. § 102.

Furthermore, *Roberts* does not teach, suggest or give any incentive to make the needed changes to reach the presently claimed invention. Absent the examiner pointing out some teaching or incentive to implement *Roberts* such that an optimization model used to customize the layout areas is at least one of a transportation model, a network model, or a generalized network model, one of ordinary skill in the art would not be led to modify *Roberts* to reach the present invention when the reference is examined as a whole. Absent some teaching, suggestion or incentive to modify *Roberts* in this manner, the presently claimed invention can be reached only through an improper use of hindsight using the applicant's disclosure as a template to make the necessary changes to reach the claimed invention.

IV. 35 U.S.C. § 102, Alleged Anticipation, Claims 1, 9, 10, 18, 19, and 27

The examiner has rejected claims 1, 9, 10, 18, 19, and 27 under 35 U.S.C. § 102(e) as being anticipated by Jacobi et al. (U.S. Patent No. 6,317,722 B1) (hereinafter "*Jacobi*"). This rejection is respectfully traversed.

Claim 1, which is representative of the other rejected independent claims 10 and 19 with regard to similarly recited subject matter, is amended to incorporate the subject matter of claims 5-7. Since the present rejection under *Jacobi* does not reject the subject matter of claims 5-7 under *Jacobi*, applicant respectfully submits that *Jacobi* does not teach every element of the claimed invention arranged as they are in the claims. Specifically, *Jacobi* does not teach an optimization model used to customize the layout areas that is at least one of a transportation model, a network model, or a generalized network model.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference,

arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983).

Thus, *Jacobi* does not teach each and every feature of independent claims 1, 10, and 19 as is required under 35 U.S.C. § 102. At least by virtue of their dependency on independent claims 1, 10, and 19, the specific features of dependent claims 9, 18, and 27 are not taught by *Jacobi*. Accordingly, applicant respectfully requests withdrawal of the rejection of claims 1, 9, 10, 18, 19, and 27 under 35 U.S.C. § 102.

Furthermore, *Jacobi* does not teach, suggest or give any incentive to make the needed changes to reach the presently claimed invention. Absent the examiner pointing out some teaching or incentive to implement *Jacobi* such that an optimization model used to customize the layout areas is at least one of a transportation model, a network model, or a generalized network model, one of ordinary skill in the art would not be led to modify *Jacobi* to reach the present invention when the reference is examined as a whole. Absent some teaching, suggestion or incentive to modify *Jacobi* in this manner, the presently claimed invention can be reached only through an improper use of hindsight using the applicant's disclosure as a template to make the necessary changes to reach the claimed invention.

V. 35 U.S.C. § 102, Alleged Anticipation, Claims 1, 8, 9, 10, 17, 18, 19, 26, and 27

The examiner has rejected claims 1, 8, 9, 10, 17, 18, 19, 26, and 27 under 35 U.S.C. § 102(e) as being anticipated by Kent (U.S. Patent Publication No. 2002/0040374 A1) (hereinafter "*Kent*"). This rejection is respectfully traversed.

As to claim 1, the examiner states:

> Kent also discloses a method including steps of developing models to predict customer purchases (Kent at FIG. 4 at 100 and Paras.0062-0068, "automatic personalization software program"), scoring customers for each predictive model (Kent at Paras. 0066-0068, "establishes priorities

based upon criteria"), determining specific layout areas (Kent at Paras. 0091 and 0095-0096, "standard design template" or "an aesthetically pleasing, readable final page"), determining where a particular product can be placed in the layout (Kent at Para. 0098, "match the relevant content and advertising, with a particular subscriber's predetermined desires and preferences"), and using an optimization model to customize the layout for customers (Kent at FIG. 5 at 48, Paras. 0077-0082, "optimization program, " and Paras. 0098-0099, "final content of publication is variable").

Office Action dated September 26, 2005, pages 7-8.

Claim 1, which is representative of the other rejected independent claims 10, and 19 with regard to similarly recited subject matter, reads as follows:

1. A computer implemented method for customizing direct marketing materials, comprising:

developing models to predict customer purchases;

scoring customers for each predictive model;

determining specific layout areas;

determining where a particular product can be placed in the layout areas; and

using an optimization model to customize the layout areas for customers, wherein the optimization model used to customize the layout areas is at least one of a transportation model, a network model, or a generalized network model.

Claims 1, 10, and 19 have been amended to incorporate the subject matter of claim 5-6, 14-16, and 23-24, and thus, the following arguments are directed toward the combination of *Kent* and Cornuejols (hereinafter "*Cornuejols*") as applied to the dependent claims.

The examiner bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). In this case, the *Kent* and *Cornuejols* do not teach or suggest all of the features asserted to be present by the examiner. Also, the cited references do not provide any teaching, suggestion, or incentive to combine or modify the teachings in the manner necessary to reach the presently claimed invention.

Kent and *Cornuejols*, taken alone or in combination fail to teach or suggest an optimization model to customize the layout areas for customers, wherein the optimization

model used to customize the layout areas is at least one of a transportation model, a network model, or a generalized network model.

Kent is directed producing a mass distributed publication through the creation of a plurality of subscriber specific versions, includes obtaining subscriber profile information relating to the nature of the subscriber's content preferences. *Kent* selects content items from content databases, based upon the subscriber's content preferences. The examiner acknowledges that *Kent* does not teach an optimization model to customize the layout areas for customers, wherein the optimization model used to customize the layout areas is at least one of a transportation model, a network model, or a generalized network model. However, the examiner alleges that *Cornuejols* teaches such features.

"It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *In re Hedges*, 228 U.S.P.Q. 685, 687 (Fed. Cir. 1986). *Cornuejols* is directed to quantitative methods for management sciences and provides for a formal quantitative approach to problem solving. More specifically, the cited sections of *Cornuejols* are directed to network optimization that is a special type of linear programming model (see section 11.1). *Cornuejols* relates a network to consist of points and lines that connect pairs of points (see section 11.2). While the terms "transportation model," "network model," and "generalized network model" may appear in the *Cornuejols* reference. None of the terms nor is the entire *Cornuejols* reference directed to customizing direct marketing materials. No teaching, suggestion, or incentive is present to combine the teachings of *Kent* with the teaching of *Cornuejols* in the manner asserted by the examiner. That is, *Kent* does not teach or suggest an optimization model to customize the layout areas for customers, wherein the optimization model used to customize the layout areas is at least one of a transportation model, a network model, or a generalized network model. *Cornuejols* may teach a transportation model, a network model, and a generalized network model, but this cited reference is not directed to customizing direct marketing materials.

Furthermore, there is not so much as a suggestion in the *Kent* or *Cornuejols* references to modify the references to include such features. The mere fact that a prior

art reference can be readily modified does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Laskowski*, 871 F.2d 115, 10 U.S.P.Q.2d 1397 (Fed. Cir. 1989) and also *see In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992) and *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1993). The examiner may not merely state that the modification would have been obvious to one of ordinary skill in the art without pointing out in the prior art a suggestion of the desirability of the proposed modification.

In this case, teaching or suggestion is present in *Kent* and *Cornuejols*, either alone or in combination, to teach or suggest the needed modifications. That is no teaching or suggestion is present in either reference that a problem exists for which using an optimization model to customize the layout areas for customers, wherein the optimization model used to customize the layout areas is at least one of a transportation model, a network model, or a generalized network model, is a solution. To the contrary, *Kent* only teaches producing mass distributed publication through the creation of a plurality of subscriber specific versions, which is a one-to-one model. *Cornuejols* teaches a formal quantitative approach to problem solving. Neither reference recognizes a need to perform the features, or similar features, as recited in claims 1, 10, and 19.

Moreover, neither *Kent* nor *Cornuejols* teaches or suggests the desirability of incorporating the subject matter of the other when these cited references are considered as a whole by one of ordinary skill in the art. That is, there is no motivation offered in either reference for the alleged combination. The examiner alleges that the motivation for the combination is "to advantageously provide a quick and intuitive approach to customizing a layout (*Cornuejols* at § 11.1)." As discussed above, *Cornuejols* is directed to network optimization that is a special type of linear programming model, which *Cornuejols* provides an exemplary network of a phone network. Thus, the only teaching or suggestion to even attempt the alleged combination is based on a prior knowledge of applicant's claimed invention thereby constituting impermissible hindsight reconstruction using applicant's own disclosure as a guide.

One of ordinary skill in the art, being presented only with *Kent* and *Cornuejols*, and without having a prior knowledge of applicant's claimed invention, would not have found it obvious to combine and modify *Kent* and *Cornuejols* to arrive at applicant's

claimed invention. To the contrary, even if one were somehow motivated to combine *Kent* and *Cornuejols*, and it were somehow possible to combine the two systems, the result would not be the invention, as recited in claims 1, 10, and 19. The result would be removing an entire user environment using a well known element.

Thus, *Kent* and *Cornuejols*, taken alone or in combination, fail to teach or suggest all of the features in independent claims 1, 10, and 19. At least by virtue of their dependency on claims 1, 10, and 19, the specific features of claims 2-4, 8, 9, 11-13, 17, 18, 20-22, 26, and 27 are not taught or suggested by *Kent* and *Cornuejols*, either alone or in combination. Accordingly, applicant respectively requests withdrawal of the rejection of claims 1, 8, 9, 10, 17, 18, 19, 26, and 27 under 35 U.S.C. § 102 or 103.

VI. 35 U.S.C. § 103, Alleged Obviousness, Claims 2, 11, and 20

The examiner rejects claims 2, 11, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Kent (U.S. Patent Publication No. 2002/0040374 A1) in view of Mohr et al. (U.S. Patent No. 6,826,727 B1) (hereinafter "*Mohr*"). This rejection is respectfully traversed.

Claims 2, 11, and 20 are dependent on independent claim 1, 10, and 19, thus, these claims distinguish over *Kent* and *Cornuejols* for at least the reasons noted above with regards to claims 1, 10, and 19. Moreover, *Mohr* does not provide for the deficiencies of *Kent* and *Cornuejols* and thus, any alleged combination of *Kent*, *Cornuejols*, and *Mohr* would not be sufficient to reject claims 1, 10, and 19 or claims 2, 11, and 20 by virtue of its dependency. That is, *Mohr* does not teach or suggest an optimization model to customize the layout areas for customers, wherein the optimization model that is used to customize the layout areas is at least one of a transportation model, a network model, or a generalized network model. Accordingly, applicant respectfully requests withdrawal of the rejection of claim 2, 11, and 20 under 35 U.S.C. § 103(a).

VII. 35 U.S.C. § 103, Alleged Obviousness, Claims 3, 12, and 21

The examiner rejects claims 3, 12, and 21 under 35 U.S.C. § 103(a) as being unpatentable over *Kent* (U.S. Patent Publication No. 2002/0040374 A1) in view of McCormick et al. (U.S. Patent Publication No. 2002/0059339 A1) (hereinafter "*McCormick*"). This rejection is respectfully traversed.

Claims 3, 12, and 21 are dependent on independent claim 1, 10, and 19, thus, these claims distinguish over *Kent* and *Cornuejols* for at least the reasons noted above with regards to claims 1, 10, and 19. Moreover, *McCormick* does not provide for the deficiencies of *Kent* and *Cornuejols* and thus, any alleged combination of *Kent*, *Cornuejols*, and *McCormick* would not be sufficient to reject claims 1, 10, and 19 or claims 3, 12, and 21 by virtue of its dependency. That is, *McCormick* does not teach or suggest an optimization model to customize the layout areas for customers, wherein the optimization model that is used to customize the layout areas is at least one of a transportation model, a network model, or a generalized network model. Accordingly, applicant respectfully requests withdrawal of the rejection of claim 3, 12, and 21 under 35 U.S.C. § 103(a).

VIII. 35 U.S.C. § 103, Alleged Obviousness, Claims 4, 13, and 22

The examiner has rejected claims 4, 13, and 22 under 35 U.S.C. § 103(a) as being unpatentable over *Kent* (U.S. Patent Publication No. 2002/0040374 A1) in view of Dowling ("Breaking the Pagination Rules," Catalog Age, June 1997, 77-79) (hereinafter "*Dowling*"), and further in view of Weiss (U.S. Patent No. 6,801,333) (hereinafter "*Weiss*"). This rejection is respectfully traversed.

Claims 4, 13, and 22 are dependent on independent claim 1, 10, and 19, thus, these claims distinguish over *Kent* and *Cornuejols* for at least the reasons noted above with regards to claims 1, 10, and 19. Moreover, *Dowling* and *Weiss* do not provide for the deficiencies of *Kent* and *Cornuejols* and thus, any alleged combination of *Kent*, *Cornuejols*, *Dowling* and *Weiss* would not be sufficient to reject claims 1, 10, and 19 or claims 4, 13, and 22 by virtue of its dependency. That is, *Dowling* and *Weiss* do not

teach or suggest an optimization model to customize the layout areas for customers, wherein the optimization model that is used to customize the layout areas is at least one of a transportation model, a network model, or a generalized network model. Accordingly, applicant respectfully requests withdrawal of the rejection of claim 4, 13, and 22 under 35 U.S.C. § 103(a).

IX. Conclusion

It is respectfully urged that the subject application is patentable over the prior art of record and is now in condition for allowance. The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

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